

**Remarks**

The Office Action mailed July 19, 2007 has been carefully reviewed and the following amendment is submitted in consequence thereof.

The Commissioner is asked to consider this a petition for a two-month extension of time from October 19, 2007 to and including December 19, 2007 and is hereby authorized to charge deposit account number 01-2384 for two one-month extension of time set forth in 37 CFR 1.17(a) of \$460.00. The present Amendment is therefore timely filed.

Claims 1-7 and 9-29 are now pending in this application, of which claims 1, 9 and 29 have been amended. It is respectfully submitted that the pending claims define allowable subject matter.

Applicants will now respond to the issues noted in the Office Action in the order set forth therein.

**I. The § 112 Rejections**

The rejections of claims 1-7 and 9-29 under 35 U.S.C. § 112, ¶ 2 is respectfully traversed.

The Office Action states the following on page 2:

Applicants are advised that there is insufficient structure set forth in claims 1 and 9 for a mere pole with a handle and no other structure to effect the function of pivoting much less movement about two or three axes. In like manner there is insufficient structure set forth in claims 28 and 29 for a mere pole with a handle to effect pivoting of the handle about two axes as claimed.

Notably, the rejection does not state that the claims are ambiguous, unclear, or not amenable to reasonable interpretation. Rather, the position taken in the Office Action appears to reflect a general objection to recitations expressed in functional language.

In reply, Applicants once again submit that “insufficient structure” is not a basis for a § 112 ¶ 2 rejection where the claim is otherwise clear. Applicants refer to the Office Examination Policy regarding rejections under Section 112 that, consistent with the applicable law, notes that

the essential question under § 112 ¶ 2 is whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. If the scope of the invention sought to be patented cannot be determined from the language of the claims, a § 112 ¶ 2 rejection is appropriate. Such rejections are inappropriate, however, when the disclosure and claims are sufficient for one skilled in the art to understand. The present claims are submitted to be clear, precise and particular in their scope, which is all that § 112 ¶ 2 requires.

MPEP § 2173.02 cautions the Office that an examiner should not reject claims or insist on their own preferences if other modes of expression satisfy the statutory requirements. In the instant rejection, the Office appears to strongly advocate a preference of structure recited in the claims to effect the recited function in the claims. Nowhere, however, does § 112 require recital of structure in the manner suggested in the Office Action. Indeed, MPEP § 2173.04 notes that if the enabling disclosure of the specification is not commensurate with the scope of the claim, that fact does not render the claim imprecise or indefinite or otherwise noncompliant with § 112 ¶ 2. Applicants need not, therefore, recite in the claims specific structure disclosed in the specification to satisfy § 112 ¶ 2. Applicants are free to draft claims having a scope that is not necessarily limited to the particular embodiments disclosed, and as long as they do with sufficient particularity and clarity, the Office should not object unless other requirements of patentability are not met.

It is also clear from MPEP § 2173.04 that breadth of claim does not render it indefinite, and if the scope of a claim is clear (metes and bounds) then it complies with § 112 ¶ 2. MPEP § 2173.05(g) also states that functional language does not, in itself, render claim language indefinite. That is, a functional limitation must be evaluated and considered, just like any other limitation of the claim – for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. The scope of the present claims, including structure and functional aspects thereof, are submitted to be readily ascertainable and understood by those in the pertinent art. Consequently, claims 1-7 and 9-29 are submitted to meet the requirements of § 112 ¶ 2.

In paragraph 9 on page 4 of the Office Action, the Office appears to assert that if structure was not necessary to be recited, the provisions of § 112 ¶ 6 would be vitiated.

Applicants submit in reply that, to the extent that the argument is understood, it is simply inaccurate. While § 112 ¶ 6 authorizes a particular type of claim drafting that implicates functional language, it does not preclude functional language in other types of claims. Indeed, Applicants point out that two notable cases regarding functional language that are cited in MPEP § 2173.5(g), namely In re Swineheart and In re Vanezia, did *not* involve means plus function claims per § 112 ¶ 6.

Applicants further note that while § 112 ¶ 6 is available to Applicants as one type of permissible claim format, means plus function claims per § 112 ¶ 6 are not required to be used by any applicant. Applicants note that no attempt has been made on the present record to invoke the provisions of § 112 ¶ 6, nor do Applicants believe that there is any reasonable question whether § 112 ¶ 6 should apply to the present claims.

It is noted that claims 1, 9 and 29 have been amended for readability only, and not in acquiescence with the 112 ¶ 2 rejections. It is not believed that the amendments to claims 1, 9 and 29 change the scope or substance of the claims, but simply more concisely capture the subject matter claimed.

Applicants accordingly request that the rejection of the claims under § 112 ¶ 2 be reconsidered and withdrawn.

## II. The Section 103 Rejections

The pending claims stand rejected as obvious over one or more combinations of the Lu '055, Schafer '064, Cheng '146 and the Lin et al. '089 references. The rejections are considered below after some preliminary remarks.

### A. The Present Obviousness Rejections are Incomplete

It is respectfully submitted that the present § 103 rejections do not include a reasoned discussion of the language of any of the pending claims and the teaching of the cited art in relation to the subject matter being claimed, but rather the Office Action only expresses general

conclusions of obviousness. No meaningful comment regarding corresponding components, relationships and/or functionality disclosed in the cited art and/or expressly recited in the claims has been provided in the Office Action. Applicants respectfully submit that such a superficial application of cited art is generally insufficient to establish a *prima facie* case of obviousness, and kindly ask that in any future correspondence the Office explicitly states the grounds of rejection, with articulated rationale, for the specific subject matter claimed in each of the independent and dependent claims pending in the application.

While the dependent claims appear to be generally overlooked in the Office Action, the Office policy of compact prosecution requires a detailed review of both independent and dependent claims. In particular, it is Office policy to promote full and complete examination in as few Office Actions as possible to avoid piecemeal prosecution. As noted in the MPEP, it is in the interests of the Applicants and the public that a case be confined to as few actions as is consistent with a thorough examination of its merits. MPEP § 706.07(a).

In the spirit of expediting the present prosecution, Applicants will nonetheless respond with detailed comment regarding the cited art and the patentability of the subject matter being claimed.

B. The Lu References and the 1.132 Declaration of Record

It is respectfully submitted that the Office Action evidences some confusion regarding multiple “Lu” references of record in the present prosecution. It is noted that in the previous Office Action, rejections were made to the claims both over Lu ‘344 and Lu ‘055. In Applicants previous response, a Declaration under Rule 1.132 was submitted to overcome the rejections based on the Lu ‘344 Patent and argument was presented against the rejections predicated on the Lu ‘055 Patent.

In the present Office Action, no rejection of the claims based on the Lu ‘344 reference was made, but rejections based on the Lu ‘055 references remain. In paragraphs 5-7 of the present Office Action, reference is made to the “Lu reference” and the deficiency of the declaration submitted. Applicants understand the “Lu reference” in these paragraphs as the Lu

'344 Patent which the Declaration discusses, and not the Lu '055 reference that is relied upon in the present rejection.

To clarify the record, Applicants traverse the reasons in paragraphs 5-7 of the present Office Action that the declaration at issue was insufficient. The declaration was submitted under Rule 1.132 rather than Rule 1.131 as the Office Action states, and the requirements of Rule 1.131 and 1.132 are not the same. The comments in paragraphs 6 and 7 regarding the requirements of Rule 1.131 are inapplicable to the declaration at issue. The declaration was *not* submitted to demonstrate prior invention under Rule 1.131. The declaration *was* submitted, as Rule 1.132 permits, to demonstrate that the inventor of the Lu '344 reference was associated with the present Applicants and learned of the invention from the present Applicants, such that the disclosure of the Lu '344 Patent is a description of the present Applicants own prior work. The declaration is believed to be sufficient to meet the requirements of Rule 1.132, which Applicants reiterate are not the same requirements for a submission under Rule 1.131. The Rule 1.132 declaration is respectfully submitted to be sufficient to remove the Lu '344 reference from the prior art that can be used to reject the present claims.

Applicants wish to note the Lu '055 reference lists the same inventor as the Lu '344 Patent, and the application that was published as the Lu '055 reference was filed a bit more than a year after the application that became the Lu '344 Patent. Upon information and belief, the circumstances explained in the 1.132 Declaration also apply to the Lu '055 reference, such that the Lu '055 reference also is a description of prior work of the present Applicants that was communicated to the inventor of the Lu '055 reference in the course of business relationships wherein Mr Lu was proposing to manufacture products on behalf of the present assignee. That is, Applicants do not believe that the Lu '055 reference is "prior art" to the presently claimed invention either. Notwithstanding this belief, it is not presently believed to be necessary to disqualify the Lu '055 reference to overcome the present rejection based upon the Lu '055 Reference for the reasons explained below. Applicants reserve the right and the opportunity to submit evidence to disqualify Lu '055 as prior art if the Office persists in asserting this reference against the claims.

C. The Section 103 Rejections Asserted

The Section 103 rejections will now be considered in the order set forth in the Office Action.

1. Lu '055 in view of Schafer '064

The rejection of claims 1-7 and 9-29 under 35 U.S.C. § 103(a) as being unpatentable over Lu '055 in view of Schafer '064 is respectfully traversed.

In paragraph 2 on page 2 of the Office Action it is stated that:

Claims 1-7 and 9-29, insofar as they are complete are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 12 above, and further in view of Lu '055 in view of Schafer '064, both of record.

It is presumed that “the reference as applied to claim 12 above” in the rejection was inadvertent, as there is no preceding reference applied to claim 12 in the Office Action. Applicants will therefore respond on the understanding that the rejection was intended to rely only upon Lu '055 in view of Schafer '064.

It is not believed that Lu '055 in view of Schafer '064 presents a prima facie case of obviousness of the subject matter presently being claimed. The Office Action states only the following in paragraph 2 on page 2:

To have secured the handle of Lu to a parallelepiped case with the handle oriented along the top of the case in the manner taught by Schafer would have been obvious to one of ordinary skill in the art.

It is respectfully submitted that this explanation is not legally sufficient to support an obviousness rejection. In KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007), the Court clearly stated that the obviousness analysis should be made explicit to facilitate review (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with

some rational underpinning to support the legal conclusion of obviousness"). The court in KSR also made it clear that obviousness is not proved merely by demonstrating that each of its elements was, independently, known in the prior art.

The present explanation of the rejection as set forth above is respectfully submitted to be "merely conclusory" because no articulated reasoning or rational underpinning of the rejection has been provided. In short, the Office Action provides no hint regarding *why* any of the claims are allegedly obvious and *how* the teaching of Lu '055 in view of Schafer '064 relates to or otherwise supports the rejection. It is respectfully submitted that the rejection as it presently stands grossly oversimplifies the language of the claims at issue and fails to take into account the actual disclosures of the cited references. For example, all the cited references disclose handles oriented along the top of the case, so *why* the Shafer reference is being singled out as pertinent to the claimed invention is far from clear.

Applicants wish to point that the Lu '055 reference is simply silent regarding many of the features presently claimed. Likewise, the Schafer '064 reference fails to disclose many of the features now claimed. Differences between the Lu '055 reference and the Schafer '064 reference, and also between the Lu '055 reference and the Schafer '064 reference weigh against obviousness of the subject matter being claimed.

For example, independent claims 1, 9, 28 and 29 all recite, among other things, a towing handle having a grip with a principal dimension and in the retracted position, the grip portion is arranged so that the principal dimension is generally perpendicular to the wheel rotation axis. The Lu '055 reference nowhere discloses or suggests such a feature. In fact, Lu '055 fails to describe a retracted position for the handle at all, and nowhere suggests that the position of the handle in the retracted position would be anything other than conventional. Applicants point out that in the Lu '344 Patent of record, a handle construction is disclosed that is not unlike the conventional handle structures discussed in the present specification in paragraphs 10-13, for example, in that the handle is oriented parallel to the wheel axis when retracted. That is, the Lu '344 and the Lu '055 references of the same inventor, are believed to be typify a common, and conventional handle configuration at least as far as the orientation of the handle in the retracted position is concerned. Consequently, Lu '055 is not suggestive in any way that any other

orientation of the handle is or would be desirable. Schaefer '064 does not cure this deficiency and is also not suggestive of the features now claimed.

Schaefer '064 discloses a handle construction that when retracted as shown in Figure 1 has no principal dimension at all. The handles 40 and 42.1 (shown in Figure 2) of Schaefer '064 are of equal dimension and are extended along a narrow edge and a long edge, respectively, of the case when retracted as shown in Figure 1. The position of the handles 40 and 42.1 along the side edges of the bag are akin to the handle configurations discussed in paragraphs 10-13 of the present specification that are believed to be problematic. The Schaefer '064 handle configuration would suffer from similar disadvantages discussed in paragraphs 10-13 of the present specification, and for this reason the Schaefer '064 handle is not believed to add anything to the teaching of Lu '055 with respect to the present invention. Accordingly, Lu '055 in view of Schaefer '064 does not present a *prima facie* case of obviousness of claims 1, 9, 28 and 29 because the references collectively fail to disclose all the features claimed.

The rejection appears to be based on in impermissible hindsight reconstruction of the invention rather than based on any contextual reading of the references asserted. In KSR, the Supreme Court cautioned that obviousness conclusions should not rely on *ex post* reasoning. Temptations to read the teaching of an invention into the prior art, and to view the prior art with hindsight in light of the teaching of an invention, should be resisted. That is, the teachings of a patent disclosure should not affect the hypothetical analysis of what a person of ordinary skill, without having the benefit of the patent disclosure, would have done at the time of the invention. Neither the cited art nor the present Office Action supplies any reason or analysis of what a person of ordinary skill, using common sense, would have done at the time the invention was made.

Additionally, independent claims 1, 28 and 29 all recite handles that are pivotable about at least two axes at the distal end of a towing arm. Claim 9 recites a handle that is pivotable about at least three axes. Neither Lu '055 nor Schaefer '064 describe these features. Particularly with respect to the Lu '055 reference, the disclosure nowhere identifies, mentions, or describes such features, and it is not believed that one of ordinary skill in the art, reading the disclosure of the Lu '055 Patent, would in any way come to any realization or appreciation of the subject

matter presently being claimed. Schaefer '064 would not cure such deficiencies because it discloses a handle section that is pivotable about a single axis. As such, Lu '055 in view of Schaefer '064 do not fairly suggest all the recitations of independent claims 1, 9, 28 and 29.

Finally, Applicants note and incorporate the detailed argument in Applicants' previous response regarding inconsistencies in the disclosures of the Shafer invention and the disclosure of the Lu '055 patent that are believed to teach away from one another on material points of the invention. In view of these inconsistencies and incompatibilities, it is not believed that one of ordinary skill in the art would have combined features of the Lu '055 and the Shafer '064 inventions, or that one of ordinary skill in the art would have considered the Shafer '064 reference to add anything to the teaching of the Lu '055 patent with respect to towable handle structures.

For at least these reasons all the independent claims 1, 9, 28 and 29 are believed to be patentable over Lu '055 in view of Schaefer '064. The clarifying details recited in the independent claims are likewise not fairly disclosed or suggested by Lu '055 in view of Schaefer '064 and are also submitted to be patentable.

Applicants accordingly request that the rejection of claims 1-7 and 9-29 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

2. Lu '055 in view of Chang '146

The rejection of claims 1-7 and 9-29 under 35 U.S.C. § 103(a) as being unpatentable over Lu '055 in view of Cheng '146 is respectfully traversed.

Lu '055 is believed to be deficient in disclosing aspects of the claimed subject matter for the reasons set forth above. Chang '146 is cited for teaching a recess in the top face to secure the pivoting handle with the major dimension oriented perpendicular to the rear face and the axis of the wheels. Applicants traverse this view of the Chang '146 reference, and again submit that the rejection is "merely conclusory" and insufficient to be sustained in its current form.

The written disclosure of Chang '146 provides no textual support for the position taken by the Office, and insofar as Applicants understand it the rejection appears to be based on Figure 2 of the Chang '146 reference. Figure 2, however, does not even appear to meet the characterization of the reference set forth in the rejection, let alone the language of the claims. The axis of the handle in Figure 2 of Chang '146 is not perpendicular to the rear face or to the axis of the wheels as the Office Action suggests. Rather, the axis of the handle is noticeably oblique and is not generally parallel to the rear face and the axis of the wheels. It is likewise clearly oblique with respect to the top face of the luggage. Judging from the written description, it is not clear that Chang '146 discloses a workable device at all, and certainly does not describe or suggest the subject matter presently being claimed.

It is therefore respectfully submitted that Lu '055 in view of Cheng '146 does not present a *prima facie* case of obviousness for the present claims. Cheng '146 does not cure the deficiencies of Lu '055 to render the subject matter of the independent claims 1, 9, 28, and 29 obvious. Cheng '146 does not cure the deficiencies of Lu '055 with respect to the dependent claims either.

Applicants accordingly request that the rejection of claims 1-7 and 9-29 as being unpatentable over Lu '055 in view of Cheng '146 be reconsidered and withdrawn.

3. Lin et al. '109 ' in view of Shafer '064 or Chang '146

The rejection of claims 1-6, 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Lin et al. '109 ' in view of Shafer '064 or Chang '146 is respectfully traversed.

Lin et al. '109 does not cure the deficiencies, *vis-à-vis* the present claims, of either Schaefer '064 or Chang '146 as discussed above. In fact, Lin et al. '109 directly teaches away from the recitations in the independent claims stating that in the retracted position the grip portion is arranged so the principal dimension is generally perpendicular to the wheel rotation axis. Lin et al. '109 teach precisely the opposite at least in paragraph [0036] wherein the handle grip (20) is described as extending parallel to a straight line between the wheels in a normal

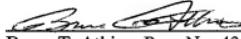
unused position. Lin et al. '109 therefore stands in direct conflict with the present independent claims on this aspect and Lin et al. '109 in view of Shafer '064 or Chang '146 does not present a prima facie case of obviousnesss for the independent claims or their associated dependent claims.

Applicants accordingly request that the rejection of claims 1-6, 28 and 29 as being unpatentable over Lin et al. '109 ' in view of Shafer '064 or Chang '146 be reconsidered and withdrawn.

III. Conclusion

In view of the foregoing remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



Bruce T. Atkins, Reg. No. 43,476  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, MO 63102-2740  
(314) 621-5070